UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,392	08/20/2004	Peter J Dronzek JR.	181-037	7246

47888 7590 11/19/2007

HEDMAN & COSTIGAN P.C.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER	
CHANG, VICTOR S	
ART UNIT	PAPER NUMBER
1794	
MAIL DATE	DELIVERY MODE
11/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/505,392	DRONZEK ET AL.	
	Examiner	Art Unit	
	Victor S. Chang	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2007 and 07 September 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-53* is/are pending in the application.

4a) Of the above claim(s) *12-53* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 8-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Introduction

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' amendments and remarks filed on 10/31/2007 and 9/7/2007 have been entered. Claims 1 and 10 have been amended. Claims 1-6 and 8-11 are active.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. In response to the amendment, the grounds of rejection have been rewritten as set forth below.

Rejections Based on Prior Art

4. Claims 1-6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer [US 6328340] in view of Caputo et al. [US 4840270].

Fischer's invention relates to a form having a detachable card. Fig. 1 shows a form sheet 1 of paper and a piece of a substrate material 2. The substrate 2 further comprises a substrate layer 21, a peeling adhesive layer 22, an outer layer 23, and a permanent pressure-sensitive adhesive layer 24. The substrate 2 is adhered to the lower surface of form 1 by means of the permanent pressure-sensitive adhesive layer 24. A piece of a covering material 4, which

comprises an outer layer 41 and a permanent pressure-sensitive adhesive layer 42, is provided on the front of the form. The outer layers 23 and 41 are transparent plastic films, such as polyester films [col. 4, lines 46-57]. A punching (die cut) runs all the way through the layers 41, 42, 1, 24, 23 and 22 and reaching down as far as the substrate layer 21 [col. 4, line 62 through col. 5, line 5]. During detaching of the card 3, the peeling adhesive 22 is completely detached from the substrate layer 21 and stays with the card. The peeling adhesive layer 22 has a non-permanent adhesive effect with respect to the substrate 21 and a permanent adhesive effect with respect to the outer layer 23 [col. 5, lines 12-16]. The different adhesive effects with respect to the substrate layer 21 and the outer layer 23 can be achieved by a suitable process control and/or different pretreatment of the surfaces of the layers 21 and 23 [col. 3, lines 28-36]. The detachment from the substrate material 21 has caused layer 22 to lose its stickiness, so that the card 3 is not self-adhesive, and the no longer sticky peeling adhesive layer can be written or printed [col. 5, lines 19-22].

For claims 1, 2, 5 and 8-11, Fischer is silent about 1) the surface treatment pattern is characterized by a differential treatment, wherein the surface contains treated area and non-treated area, 2) the percentage of treated area. However, regarding item 1), Caputo's invention relates to a resealable lable flap. Fig.1 shows that a selected zone of a surface has been corona treated (differentially treated). The pressure sensitive label-flap is adhered to both untreated and a circular corona treated area (a closed curve). The thermoplastic surface treated with a corona discharge provides a surface for a stronger bond between to the pressure sensitive adhesive and the remaining untreated surface provides a weaker bond with the same pressure sensitive adhesive. Since Fischer teaches that the different adhesive effects with respect to the substrate

layer 21 and the outer layer 23 can be achieved by a suitable process control and/or different pretreatment of the surfaces of the layers 21 and 23, it would have been obvious to one of ordinary skill in the art of surface treatment to select Caputo's differential treatment method to obtain the required level of adhesion, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding item 2), since Caputo shows the differentially treated structure effects the releasablility of the adhesive to the label flap, a workable percentage of treated area over the surface to achieve the required adhesiveness is deemed to be an obvious routine optimization to one skilled in the art, motivated by the desire to obtain the required adhesiveness dictated by the same end use. It should be noted that applicants have recited in claim 1 a group of three different structural embodiments for selective variable adhesion. While the second embodiment has been amended, the previously relied upon teachings of prior art remain reading on the first embodiment as claimed.

For claims 3 and 4, Fischer is silent about the thickness of polyester film layer and the weight basis of the paper stock. However, since Fischer teaches the generally same subject matter for the same use (detachable card intermediate) as the instant invention, a workable thickness of polyester film and weight basis of paper stock are deemed to be either anticipated by Fischer, or obvious routine optimizations to one skilled in the art of detachable card intermediate, motivated to obtain required card physical properties for the same use.

For claim 6, Fischer is silent about the amount of difference in adhesion. However, since Fischer teaches the generally same subject matter for the same use as the instant invention, a workable difference in adhesion for achieving different adhesive effects is deemed to be either

anticipated by Fischer, or obvious routine optimizations to one skilled in the art of detachable card intermediate, motivated to easily detach the card for the same use.

Response to Argument

5. Applicants' argument [Remarks pp. 12-13] directed to the second structural embodiment of the selective variable adhesion fail to exclude that the previously relied upon teachings of prior art remain reading on the first embodiment as claimed.

Applicants argue [page 14] that

> "The Caputo patent has no relation to the art of making a card intermediate as it is limited to making resealable bags. This fact points to the inescapable conclusion that one skilled in the art would even consider resealable bags in making a card intermediate."

However, since Caputo relates to methods for control adhesive effects, and Fischer teaches that the different adhesive effects with respect to the substrate layer 21 and the outer layer 23 can be achieved by a suitable process control and/or different pretreatment of the surfaces of the layers 21 and 23, Caputo's teaching is pertinent, because they are of the same technical field of endeavor. It would have been obvious to one of ordinary skill in the art of surface treatment to select Caputo's treatment method to required level of adhesion, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. Nowhere has Fischer sets a restriction on the treatment methods.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794

11/16/2007